

## **2. REMARKS / DISCUSSION OF ISSUES**

Claims 1 and 5-12 are pending in the application upon entry of the present amendment.

### **Request for Information under Rule 105**

Applicants acknowledge the request for information set forth in the Office Action. Based on the request, Applicants presume that the Examiner is requesting information under 37 C.F.R. § 1.105 (a) (1) (iii). An information disclosure statement (IDS) will be filed under separate cover to the extent necessary to comply with this request, and after the filing of this amendment. Applicants intend to file the IDS within one-month of the filing date of the present amendment, and if necessary, will pay any fee required under 37 C.F.R. § 1.136.

### **Objection to the Specification**

The objection to the specification is believed to be moot in view of the Abstract filed herewith.

### **Double Patenting Rejections**

Applicants have considered the rejections under the judicially created doctrine of obviousness-type double patenting. If necessary and proper, Applicants will file any required terminal disclaimer when all other rejections are withdrawn during the course of prosecution.

### **Rejections under 35 U.S.C. § 112, ¶2**

The amendments to the claims specifically address each rejection under 35 U.S.C. § 112, ¶2. Applicants respectfully request withdrawal of the rejections under this section of the Code in view of the present amendments to the claims.

### **Rejections under 35 U.S.C. § 103**

Claims 1-8 and 13 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kraus, Jr., et al.* (U.S. Patent 6,470,220).

Claim 9 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kraus, Jr., et al.* in view of *Ivkov* (U.S. Patent Application Publication 20060142749).

Claim 10 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kraus, Jr., et al.* in view of *Rand* (U.S. Patent Application Publication 200500669610).

Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Kraus, Jr., et al.* in view of *Frei, et al* (U.S. Patent 3,592,185).

For at least the reasons set forth below, Applicants respectfully submit that all claims are patentable over the art applied in the rejections under 35 U.S.C. § 103(a).

A *prima facie* case of obviousness has three requirements. First, the prior art relied upon, coupled with the knowledge generally available in the art at the time of the invention, requires some reason that the skilled artisan would modify a reference or to combine references.<sup>1</sup> The Supreme Court has, however, cautioned against the use of “rigid and mandatory formulas” particularly with regards to finding reasons prompting a person of ordinary skill in the art to combine elements in the way the claimed new invention does.<sup>2</sup> But rather the Supreme Court suggests a broad, flexible “functional approach” to the obviousness analysis recognizing that “[i]n many fields it may be that there is little discussion of obvious techniques or combinations.”<sup>3</sup> Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the same time the invention

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<sup>1</sup> See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005) (“[S]imply identifying all of the elements in a claim in the prior art does not render a claim obvious.”).

<sup>2</sup> See *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007) (“The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents.”).

<sup>3</sup> Id. See also Id. at 1743 F. 3d 1356 (Fed. Cir. 2006) (“Our suggestion test is in actuality quite flexible and not only permits, but *requires*, consideration of common knowledge and common sense”) (emphasis in original).

was made. In other words, a hindsight analysis is not allowed.<sup>4</sup> Lastly, the prior art reference or combination of references must teach or suggest all the limitations of the claims.<sup>5</sup>

Claim 1 recites:

*A method to determine the spatial distribution of magnetic particles in an examination area of an object of examination with the following steps:*

- a) generating a magnetic field with a spatial distribution of the magnetic field strength such that the examination area consists of a first sub-area with lower magnetic field strength and a second sub-area with a higher magnetic field strength,*
- b) changing the particularly relative spatial position of the two sub-areas in the area of examination or change of the magnetic field strength in the first sub-area so that the magnetization of the particles changes locally,*
- c) acquiring signals that depend on the magnetization in the area of examination influenced by this change, and*
- d) evaluating the signals to obtain information about the change in spatial distribution and/or the movement of the magnetic particles in the area of examination, wherein the magnetic particles comprise **a superparamagnetic material.***

Applicants respectfully submit that while *Kraus, Jr. et al.* discloses SQUIDS for magnetometric imaging of a body using ferromagnetic, ferromagnetic, diamagnetic and paramagnetic materials, there is no disclosure that the magnetic particles comprise the superparamagnetic material class of materials.

For at least the reasons set forth above, Applicants respectfully submit that the applied art fails to disclose at least one feature of claim 1. Accordingly, a *prima facie* case of obviousness cannot be established in view of *Kraus, Jr. et al.* Claim 1 is, therefore, patentable over *Kraus, Jr. et al.* Claims 5-12, which depend immediately or

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<sup>4</sup> See *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200 (Fed. Cir. 1991) (“Hindsight is not a justifiable basis on which to find that ultimate achievement of a long sought and difficult scientific goal was obvious.”).

<sup>5</sup> See *In re Wilson*, 424 F.2d 1382 (C.C.P.A. 1970) (“All words in a claim must be considered in judging the patentability of that claim against the prior art.”).

ultimately from claim 1, are patentable for at least the reasons set forth above and in view of their additionally recited subject matter.

### **Conclusion**

In view the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:  
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